



08-16-07

1634

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Patentees: Engelhardt *et al.*
U.S. Patent No.: 6,992,180 B1
Issued: January 31, 2006
Serial No.: ~~08/479,997~~ 08/046,004
Filed: June 7, 1995
For: OLIGO- OR POLYNUCLEOTIDES
COMPRISING PHOSPHATE-MOIETY
LABELED NUCLEOTIDES

Group Art Unit: 1631
Primary Examiner: John S. Brusca

527 Madison Avenue, 9th Floor
New York, NY 10022-4304
August 15, 2007

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Attention: Deborah Dotson (Telephone 571-272-0520)
Technology Center 1600

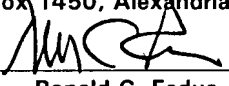
COMMUNICATION ACCOMPANYING PATENTEES' REPLY TO APRIL 10, 2006 NOTICE UNDER
37 CFR 1.251 - ABANDONED APPLICATION
(RE: U.S. SERIAL NO. 08/046,004, FILED APRIL 9, 1993)

Dear Sirs:

This Communication accompanies Patentees' reply to the Notice Under 37 CFR 1.251 - Abandoned Application that was apparently mailed or issued on April 10, 2006 in connection with their prior application, U.S. Patent Application Serial No. 08/046,004, filed on April 9, 1993. Serial No. 08/046,004 was the immediate

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predecessor to Patentees' U.S. Patent Application Serial No. 08/479,997, filed on June 7, 1995, the latter having been allowed and later issued on January 31, 2006 as their above-identified U.S. Patent No. 6,992,180 B1. Neither Patentees, their undersigned attorney nor the instant Assignee, Enzo Life Sciences, Inc. has any record to indicate that the April 10, 2006 Notice Under 37 CFR 1.251 was ever received. Recent calls to the USPTO were unsuccessful in obtaining a copy of the April 10, 2006 Notice Under 37 CFR 1.251.

EXPRESS MAIL CERTIFICATE	
"Express Mail" Label	<u>EM008702438US</u>
Deposit Date	<u>August 15, 2007</u>
I hereby certify that this paper (Communication Accompanying Patentees' Reply To April 10, 2006 Notice Under 37 CFR 1.251 – Abandoned Application) and the attachments herein are being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 on the date indicated above and is addressed to the Commissioner of Patents and Trademarks, Box Reconstruction, P. O. Box 1450, Alexandria, VA 22313-1450.	
 Ronald C. Fedus Reg. No. 32,567	<u>AUG 15 2007</u> Date

REMARKS

Earlier this year it came to the undersigned's attention from a third party who indicated that the file wrapper for Patentees' U.S. Patent Application Serial No. 08/046,004, filed on April 9, 1993, was missing from the U.S. Patent and Trademark Office's files for the family of patent applications related to U.S. Patent No. 6,992,180 B1, issued on January 31, 2006.

As a result of the third party's information, the undersigned proceeded to search the Assignee's files for Serial No. 08/046,004. The initial search included the office facilities at 527 Madison Avenue in New York City. After the file could not be located, the undersigned contacted outside counsel who were unable after several attempts to locate the file. A short time later the undersigned contacted Landon-IP, the Assignee's Washington associates, to request a copy of the file history for Serial No. 08/046,004. Landon-IP informed him that the file history was "currently marked as lost at the PTO."¹

Upon receiving this last piece of information, the undersigned proceeded to travel to the Assignee's warehouse facilities in Farmingdale, New York, in order to make a further search for the file for Serial No. 08/046,004. The search resulted in locating the file for Serial No. 08/046,004 which is being submitted concurrently with this Communication. Because the undersigned was not able to obtain the actual issued April 10, 2006 Notice Under 37 CFR 1.251 – Abandoned Application, a copy of an earlier Form PTO-2054-B (REV. 11/2000) has been retrieved, completed and also submitted with this Communication.

¹ Landon-IP also informed the undersigned that an earlier request for the file history for Serial No. 08/046,004 had been made by the Assignee in May 2005, but the file could not be located at the PTO. According to Landon-IP, a reconstruction note from the PTO was mailed to the applicant on April 10, 2006. This is the first time that the undersigned became aware of the April 10, 2006 Notice.

Accordingly, with this Communication, Patentees are submitting the following items or documents:

1. a completed, signed and reproduced (but not the original) April 10, 2006 Notice Under 37 CFR 1.251 – Abandoned Application attached as **Exhibit 1**²;
2. copy of the USPTO's Public PAIR printout for Serial No. 08/046,004 attached as **Exhibit 2**; and
3. copy of the file history for Serial No. 08/046,004 attached as **Exhibit 3**.

Lastly, before submitting this Communication and the attached exhibits (1-3), the undersigned telephoned Ms. Deborah Dotson, Technology Center 1600 (Telephone 571-272-0520) in order to request that the missing or lost file wrapper for Serial No. 08/046,004 be sent to her attention. Ms. Dotson graciously agreed that this Communication and the attached exhibits should be sent to her attention for subsequent processing and scanning into the USPTO's system.

As indicated in Notice Under 37 CFR 1.251 (Exhibit 1), "the copy of the paper(s) listed in the notice under 37 CFR 1.251 is/are a complete and accurate copy of applicant's record of such paper(s)."

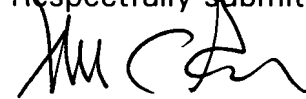
It is respectfully requested that the attached copy of the file for Serial No. 08/046,004, filed April 9, 1993, be incorporated into the USPTO's file related to U.S. Patent No. 6,992,180 B1, issued January 31, 2006. In this way, the public will be able to obtain the complete file history for the issued '180 Patent including all of its earlier applications.

² The undersigned wishes to make it perfectly clear that the attached Notice Under 37 CFR 1.251 – Abandoned Application (Exhibit 1) is not the original paper issued or mailed by the USPTO on April 10, 2006. The purpose in submitting the attached Notice Under 37 CFR 1.251 (Exhibit 1) is to expedite the processing for reconstruction of Patentees' file history for Serial No. 08/046,004, particularly in light of the undersigned's not being able to obtain a copy of the original April 10, 2006 Notice.

No fee or fees are believed to be due in connection with this Communication.
In the event that any fee or fees are due, however, The Patent and Trademark
Office is hereby authorized to charge the amount of any such fee(s) to Deposit
Account No. 05-1135, or to credit any overpayment thereto.

If a telephone conversation would further the prosecution of the present
application, Patentees' undersigned attorney requests that he be contacted at the
number provided below.

Respectfully submitted,



Ronald C. Fedus
Registration No. 32,567
Attorney for Patentees

ENZO LIFE SCIENCES, INC.
c/o ENZO BIOCHEM, INC.
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New York, NY 10022-4304
Telephone: (212) 583-0100
Facsimile: (212) 583-0150

Under the Paperwork Reduction Act of 1995 no persons are required to respond to a collection of information unless it displays a valid OMB control number.

In re Application of: Dean L. Engelhardt et al.

Application No.: 08/046,004

Filing Date: April 9, 1993

Title: Phosphate-Moiety Labeled Nucleotides

Direct to: Box Reconstruction
United States Patent and Trademark Office
Washington, DC 20231

NOTICE UNDER 37 CFR 1.251 – Abandoned Application

Statement (check the appropriate box):

☐ The copy submitted with this reply is: complete and accurate copy of applicant's record of all of the correspondence between the Office and the applicant for the above-identified application (except for U.S. patent documents); and applicant is not aware of any correspondence between the Office and applicant for the above-identified application that is not among applicant's records.

☐ The copy of the paper(s) listed in the notice under 37 CER 1.251 is/are a complete and accurate copy of applicant's record of such paper(s).

☒ The papers produced by applicant are applicant's complete record of all of the correspondence between the Office and the applicant for the above-identified application (~~except for U.S. patent documents~~), and applicant is not aware of any correspondence between the Office and the applicant for the above-identified application that is not among applicant's records.

☐ Applicant does not possess any record of the correspondence between the Office and the applicant for the above-identified application

AUGUST 15 2007
Date


Signature

Ronald C. Fedus

Typed or printed name Attorney for Applicants/Patentees

Reg. No. 32,567

A copy of this notice should be returned with the reply.

Burden Hour Statement: This collection of information is required by 37 CFR 1.251. The information is used by the public to reply in a request for copies of correspondence between the applicant and the USPTO in order to reconstruct an application file. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This form is estimated to take 60 minutes to complete. This time will vary depending on the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, Washington, D.C. 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Washington, DC 20231.



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08/046,004 MODIFIED NUCLEOTIDES, METHODS OF PREPARING AND UTILIZING AND COMPOSITIONS CONTAINING THE SAME

Select New Case	Application Data	Transaction History	Continuity Data	Address & Attorney/Agent
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Transaction History

Date	Transaction Description
04-10-2006	Mail Reconstruction Notice - Abandoned Application
05-23-2001	Termination of Official Search
04-09-2001	Official Search Conducted
09-13-2000	Termination of Official Search
09-13-2000	Official Search Conducted
04-09-1993	Initial Exam Team nn
09-09-1999	Termination of Official Search
08-09-1999	Official Search Conducted
07-14-1999	File Marked Lost
03-30-1999	Termination of Official Search
03-03-1999	Official Search Conducted
02-22-1999	Case Reported Lost
04-16-1996	Mail Abandonment for Failure to Respond to Office Action
04-15-1996	Abandonment for Failure to Respond to Office Action
12-01-1995	Withdraw Publication/Pre-Exam Abandon
12-01-1995	Mail Notice of Rescinded Abandonment
12-01-1995	Notice of Rescinded Abandonment in TCs
10-30-1995	Petition to Revive Application - Granted
06-07-1995	Petition Entered

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05-17-1995	Mail Abandonment for Failure to Respond to Office Action
05-15-1995	Abandonment for Failure to Respond to Office Action
10-04-1994	Mail Non-Final Rejection
10-03-1994	Non-Final Rejection
08-22-1994	Information Disclosure Statement (IDS) Filed
08-22-1994	Information Disclosure Statement (IDS) Filed
08-22-1994	Information Disclosure Statement (IDS) Filed
08-22-1994	Information Disclosure Statement (IDS) Filed
07-29-1994	Case Docketed to Examiner in GAU
07-28-1994	Date Forwarded to Examiner
07-25-1994	Response to Election / Restriction Filed
07-28-1994	Withdraw Publication/Pre-Exam Abandon
07-28-1994	Mail Notice of Rescinded Abandonment
07-28-1994	Notice of Rescinded Abandonment in TCs
07-28-1994	Date Forwarded to Examiner
07-25-1994	Amendment Crossed in Mail
07-25-1994	Petition to Revive Application - Granted
06-23-1994	Petition Entered
06-13-1994	Mail Abandonment for Failure to Respond to Office Action
06-13-1994	Abandonment for Failure to Respond to Office Action
11-18-1993	Mail Restriction Requirement
11-01-1993	Requirement for Restriction / Election
09-02-1993	Case Docketed to Examiner in GAU
05-18-1993	Applicant response received
07-30-1993	Application Captured on Microfilm
07-17-1993	Application Is Now Complete
05-19-1993	Notice Mailed--Application Incomplete--Filing Date Assigned
05-12-1993	Request for Applicant Statement Regarding Potential DOE Interest (45-Day Letter) Mailed

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- Call the Patent Electronic Business Center at (866) 217-9197 (toll free) or e-mail EBC@uspto.gov for specific questions about Patent Application Information Retrieval (PAIR).
- Send general questions about USPTO programs to the [USPTO Contact Center \(UCC\)](#).

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